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D E C I S I O N
of 19 July 1996

Case Number: G 0007/95
Application Number: 85305391.6
Publication Number: 0170512
IPC: A61B 17/08
Language of the proceedings: EN

Title of invention:
Coated surgical staple

Patentee:
ETHICON INC.

Opponent:
United States Surgical Corporation

Headword:
Fresh grounds for opposition/ETHICON

Relevant legal provisions:
EPC Art. 99, 100(a)(b)(c), 114(1)
EPC R. 55, 56

Keyword:
"No power to examine fresh grounds for opposition without agreement of patentee"

Decisions cited:
G 0010/91, T 0796/90, T 0018/93, T 0646/91, T 0550/88,
T 0220/83

Headnote:
In a case where a patent has been opposed under Article 100(a) EPC on the ground that the claims lack an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Articles 52(1), 54 EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lack novelty in view of the closest prior art document may be considered in the context of deciding upon the ground of lack of inventive step.



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Case Number: G 0007/95

**Decision of 24 September 1996
correcting an error in the
D E C I S I O N
of the Enlarged Board of Appeal
of 19 July 1996**

Appellant: United States Surgical Corporation
(Opponent) 150 Glover Avenue
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Connecticut 06856 (US)

Representative: Marsh, Roy David
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Respondent: ETHICON INC.
(Proprietor of the patent) U.S. Route 22
Somerville
New Jersey 08876 (US)

Representative: Mercer, Chris P.
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Decision under appeal: Interlocutory decision of the Technical Board of
Appeal 3.2.2 dated 21 September 1995 in case
T 0514/92.

Composition of the Board:

Chairman: G. D. Paterson
Members: J.-C. Saisset
C. Andries
G. Gall
W. Moser
R. Teschemacher
P. van den Berg

In application of Rule 89 EPC the decision given on
19 July 1996 is hereby corrected as follows:

Cover page: Representative "Jones, Alan John" is replaced by
"Mercer, Chris P.".

The Registrar:

The Chairman:

J. Ruckerl

G. D. Paterson



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of 19 July 1996

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Members: J.-C. Saisset
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Summary of Facts and Submissions

I. During proceedings in appeal cases T 937/91 before Technical Board of Appeal 3.2.5 (OJ EPO 1996, 25) and T 514/92 before Technical Board of Appeal 3.2.2 (OJ EPO 1996, 270) dated 10 November 1994 and 21 September 1995 respectively, these Boards of Appeal referred two related points of law to the Enlarged Board of Appeal under Article 112(1)(a) EPC.

II. In its interlocutory decision T 937/91 the Technical Board of Appeal referred to the Enlarged Board the following question (reference number G 1/95, OJ EPO 1995, 171):

"In a case where a patent has been opposed on the basis of Article 100(a) EPC, but the opposition has only been substantiated on the grounds of lack of novelty and inventive step pursuant to Articles 54 and 56 EPC, can a Board of Appeal introduce the ground that the subject-matter of the claims does not meet the conditions of Article 52(2) EPC of its own motion into the proceedings?"

III. The Technical Board of Appeal 3.2.5 had issued a communication accompanying the summons to the oral proceedings where it expressed the preliminary opinion that the subject-matter of Claim 1 seemed **prima facie** to be a mere presentation of information which was not patentable under Article 52(2)(d) EPC. In response to this communication the respondent (patentee) referred to the Opinion G 10/91 (OJ EPO 1993, 420) of the Enlarged Board of Appeal and argued that, according to this Opinion, the Board of Appeal was only entitled to consider grounds for opposition on which the decision of the opposition division had been based. The only

exception to this principle as stated by the Enlarged Board was the case where the patentee agreed that a fresh ground for opposition could be considered. Thus, the question of law is concerned with the circumstances in which, in opposition appeal proceedings, the Board of Appeal **ex officio**, or the opponent, is entitled to raise a fresh objection without the agreement of the patentee.

- IV. In appeal case T 514/92 the Technical Board of Appeal 3.2.2 cited the earlier decision T 937/91 and decided not to proceed further until the Enlarged Board of Appeal had issued a decision. It considered the definition of the legal concept "grounds for opposition" to be an important point of law (Art. 112(1) EPC) justifying reference of an additional question to the Enlarged Board of Appeal (reference number **G 7/95**, OJ 1995, 816):

"In the case where a patent has been opposed under Art. 100(a), on the basis that the claims lack an inventive step in view of documents cited in the opposition statement, and the opponent introduces during appeal proceedings a new allegation that the claims lack novelty in view of one of the documents previously cited or in view of a document introduced during the appeal proceedings, must a board of appeal exclude the new allegation because it introduces a new ground of opposition?".

- V. In the appeal case T 514/92, the appellant had raised a new objection of lack of novelty during the appeal proceedings and argued that the starting point (the relevant prior art document) had not changed and therefore the ground of lack of novelty was not a fresh ground of opposition. In the Board's view, the definition of the legal concept "ground for opposition" was the crux of the matter. A broad interpretation of

this concept would imply that both an objection against novelty as well an objection against inventive step would fall under the ground for opposition under Article 100(a) EPC. A narrow interpretation would result in the Board of Appeal's having to decide on inventive step without having first decided on novelty.

VI. The parties to both proceedings before the Enlarged Board of Appeal were invited to comment on the points of law referred to it. In appeal case T 937/91 the patentee submitted its observations by letter dated 19 April 1995. In appeal case T 514/92 the patentee submitted its observations by letter dated 7 December 1995. The other parties did not submit any observations.

VII. On 5 February 1996 the parties to appeal proceedings **G 1/95** and **G 7/95** were invited by the Enlarged Board to attend common oral proceedings in order to present their views. A communication stating the points to be discussed at oral proceedings was also sent. There, the Enlarged Board indicated three possible interpretations of the legal concept of "grounds for opposition": Article 100(a) EPC could be thus considered as being **per se** (a) a single ground for opposition; (b) various grounds for opposition; or (c) simply a list referring to a group of articles of the EPC, i.e. Articles 52 to 57 relating to patentability, in which several admissible grounds for opposition were to be found. The Enlarged Board also invited the parties to state the circumstances where, in their opinion, a Board of Appeal might be empowered, without the patentee's approval, to revoke the patent on the basis of a ground, for instance, lack of novelty, which appeared to be relevant but was not raised in the opposition procedure.

VIII. On 15 April 1996, oral proceedings took place before the Enlarged Board in the presence of the representatives of the parties in cases **G 1/95** and **G 7/95**. At the beginning of the oral proceedings it was announced by the Chairman that as the points of law referred in cases **G 1/95** and **G 7/95** were closely related, the Enlarged Board had decided to consider them in consolidated proceedings according to Article 8 of the Rules of Procedure of the Enlarged Board of Appeal.

IX. During the oral proceedings the representatives of the parties presented their main arguments. The Appellant in **G 1/95** emphasised that Article 100(a) EPC is a single ground for opposition and noted that it is the EPO's duty not to grant or maintain patents which it is convinced are not legally valid during the centralised procedure before the EPO. It must therefore be possible to consider any issue listed in Article 100(a) EPC in order to avoid costly revocation proceedings before national courts. The Respondent in **G 1/95** submitted that in the light of the EPC and of **G 10/91**, the term "grounds for opposition" meant the precise grounds substantiated in a particular opposition. The Appellant in **G 7/95** considered that Article 100(a) EPC is a single ground and that within the framework of this particular ground there could be several lines of attack, those being the grounds effectively substantiated in an opposition. Finally, the Respondent in **G 7/95** stated that a ground of opposition is not merely a heading or a reference to a part of Article 100 EPC and that Article 100(a) EPC provides a list of grounds for opposition. The Respondent further argued that it was necessary to look at the substance of the matter, not the form.

Reasons for the Decision

1. The questions referred to the Enlarged Board of Appeal by decisions T 937/91 and T 514/92 only concern opposition appeal proceedings. In both decisions it was considered that the term "grounds for opposition" was not yet sufficiently elaborated in the decisions or opinions of the Enlarged Board of Appeal. Thus, the meaning of "grounds for opposition" must be defined within the framework of Article 100 EPC in general and of paragraph (a) in particular, as well as in the light of opinion G 10/91 (OJ EPO, 1993, 408 and 420).

Meaning of "grounds for opposition" under Article 100 EPC

- 1.1 Article 100 EPC states under the heading "grounds for opposition" that:
 - "Opposition may only be filed on the grounds that:
 - (a) the subject-matter of the European patent is not patentable within the terms of Articles 52 to 57;
 - (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
 - (c) the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61, beyond the content of the earlier application as filed".

1.2 In paragraph 18 of G 10/91, the Enlarged Board considered the proper application of Article 114(1) EPC in the context of opposition appeal proceedings and stated **inter alia** that: "Although Article 114(1) EPC formally covers also the appeal procedure, it is ... justified to apply this provision generally in a more restrictive manner in such procedure than in opposition procedure. In particular with regard to **fresh grounds for opposition**, for the above reasons the Enlarged Board considers that such grounds may in principle not be introduced at the appeal stage..... However, an exception to the above principle is justified in case the patentee agrees that a **fresh ground for opposition** may be considered..... It may be added that if the patentee does not agree to the introduction of a **fresh ground for opposition**, such a ground may not be dealt with in substance in the decision of the Board of Appeal at all.....". This approach was based upon the idea that it reduced the uncertainty for patentees having otherwise to face unforeseeable complications at a very late stage of the opposition procedure.

2. The Boards of Appeal when using the term "grounds for opposition" of Article 100(a) EPC, have given it different meanings. Some Boards have applied Article 100(a) EPC, as if it were a single ground for opposition (e.g. T 796/90, T 18/93 and T 646/91), whereas other Boards have considered that lack of novelty, for instance, is **per se** a single ground for opposition (e.g. T 550/88, OJ EPO, 1992, 117 paragraph 4.1).

3.1 In Article 108 EPC, the term "grounds" in "grounds of appeal" is to be interpreted as including both the legal reasons, i.e. the legal basis, and the factual reasons,

i.e. the facts, arguments and evidence relied upon to give to the Board all the elements needed to decide whether or not the appealed decision has to be set aside (see T 220/83, OJ EPO, 1986, 249 and T 550/88 cited above, paragraph 2).

3.2 Article 138(1) EPC, in contrast, lists all the possible legal reasons for a revocation action under the law of a Contracting State. These legal reasons are the "legal basis" for such an action and it is clear that, in the different Contracting States, the revocation of a patent may be obtained on any single "legal basis" for revocation, e.g. lack of novelty, or lack of inventive step or because the invention is not susceptible of industrial application, etc. The function of Article 138 EPC is to provide, within the Contracting States, a restricted number of legal bases, i.e. a restricted number of grounds, on which a revocation may be obtained.

4. The wording of Article 100(a) EPC is the same as the wording of Article 138(1)(a) EPC. The same interpretation for the term "ground", i.e. "a legal basis", applies also for each of the grounds mentioned in Article 100(a) EPC.

4.1 The function of Article 100 EPC is to provide, within the framework of the EPC, a limited number of legal bases i.e. a limited number of objections on which an opposition can be based. All "grounds for opposition" mentioned in Article 100 EPC have their counterparts in other Articles of the EPC which have to be met during the procedure up to grant.

- 4.2 Whereas the grounds for opposition in Articles 100(b) EPC and 100(c) EPC each relate to a single, separate and clearly delimited legal basis on which an opposition can be based, i.e. insufficient disclosure and unallowable amendment before grant respectively, the same does not apply to Article 100(a) EPC.
- 4.3 Indeed, Article 100(a) EPC simply refers, apart from the general definition of patentable inventions according to Article 52(1) EPC, and the exceptions to patentability according to Article 53 EPC, to a number of definitions according to Article 52(2) to (4) and 54 to 57 EPC, which specify "invention", "novelty", "inventive step" and "industrial application" which, when used together with Article 52(1) EPC, define specific requirements and therefore form separate grounds for opposition in the sense of separate legal objections or bases for opposition.
- 4.4 The totality of these Articles (namely Articles 52 to 57 EPC) within the meaning of Article 100(a) EPC do not therefore constitute a single objection to the maintenance of the patent, but a collection of different objections, some of which are completely independent from each other (e.g. Article 53 and Articles 52(1), 54 EPC), and some of which may be more closely related to each other (e.g. Articles 52(1), 54 and Articles 52(1), 56 EPC). For an opposition to be admissible within the framework of Article 100(a) EPC, it must necessarily be based on at least one of the legal bases for an opposition, i.e. on at least one of the grounds for opposition set out in Articles 52 to 57 EPC.
- 4.5 One function of Rules 55 and 56 EPC is to establish what the notice of opposition shall contain in order to be admissible in that respect. Rule 55 EPC specifies in paragraph (c) that the notice of opposition shall

contain a statement of the extent to which the European patent is opposed and of the grounds (i.e. the legal reasons mentioned above) on which the opposition is based **as well as** an indication of the facts, evidence and arguments presented in support of these grounds, i.e. the substantiation. The wording of paragraph (c) shows clearly the distinction made between the grounds, meaning as in Article 100(a) EPC the legal reasons or legal bases, and the substantiation.

- 4.6 Accordingly, in the context of Articles 99 and 100 EPC and of Rule 55(c) EPC, a "ground for opposition" must be interpreted as meaning an individual legal basis for objection to the maintenance of a patent. It follows in particular that Article 100(a) EPC contains a collection of different legal objections (i.e. legal bases), or different grounds for opposition, and is not directed to a single ground for opposition.

Powers of the Boards of Appeal concerning fresh grounds for opposition raised during opposition appeal proceedings

5. As summarised in paragraph 1.2 above, in paragraph 18 of G 10/91, the Enlarged Board of Appeal held that, when applying Article 114(1) EPC in the context of opposition appeal proceedings, a "fresh ground for opposition" may not be introduced into the proceedings either by an opponent or by the Board of Appeal of its own motion without the agreement of the patentee. In order to answer the two referred questions, the Enlarged Board of Appeal must decide upon the scope of the term "a fresh ground for opposition" as it was used in paragraph 18 of G 10/91.

- 5.1 In paragraphs 4 to 6 of G 10/91, the Enlarged Board of Appeal carefully considered and analysed the function of Rule 55(c) EPC, and concluded that this Rule only makes sense if interpreted as having the double function of governing the admissibility of the opposition and of establishing at the same time **the legal and factual framework within which the substantive examination of the opposition in principle shall be conducted.**
- 5.2 In paragraph 16 of G 10/91, the Enlarged Board explained that, in application of Article 114(1) EPC, an Opposition Division during proceedings before it may introduce a ground for opposition which was not covered by the notice for opposition, either of its own motion or upon application by an opponent, if such a ground of opposition is considered to be sufficiently relevant in the sense there explained. If an Opposition Division does introduce such a ground into the proceedings before it, it will of course decide whether such ground of opposition prejudices the maintenance of the opposed patent, in the decision that it issues.
- 5.3 The Enlarged Board in G 10/91 first used the term "a fresh ground for opposition" in paragraph 18, in the context of considering the proper application of Article 114(1) EPC during opposition appeal proceedings (see paragraph 1.2 above). It is clear that this term is intended to refer to a ground for opposition which was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the Opposition Division in application of Article 114(1) EPC and in accordance with the principles set out in paragraph 16 of G 10/91.
- 5.4 Furthermore, having regard to the fact that the requirements for a notice of opposition which are set out in Article 99 EPC and Rule 55(c) EPC were carefully

considered in G 10/91 and having regard also to the meaning of the term "ground for opposition" which is set out in paragraph 4.7 above, the term "a fresh ground for opposition" which is used in paragraph 18 of G 10/91 must be interpreted as having been intended to refer to a new legal basis for objecting to the maintenance of the patent, which was not both raised and substantiated in the notice of opposition, and which was not introduced into the proceedings by the Opposition Division in accordance with the principles set out in paragraph 16 of G 10/91.

The referred question in G 1/95

6. This question refers to a case where an opposition has been substantiated on the grounds of lack of novelty and inventive step (Articles 52(1), 54 and 52(1), 56 EPC), but the ground that the claimed subject-matter was not an invention within the meaning of Article 52(1), (2) EPC was neither raised and substantiated in the notice of opposition, nor introduced into the proceedings by the Opposition Division. It follows from paragraph 5.2 above that the ground of unpatentable subject-matter based upon Articles 52(1), (2) EPC is a new legal basis for objecting to the maintenance of the patent, and is therefore a "fresh ground for opposition" within the meaning of this term as it is used in paragraph 18 of G 10/91, and accordingly may not be introduced into the appeal proceedings without the agreement of the patent proprietor.

The referred question in G 7/95

7. This question refers to a case where an opposition has been substantiated on the ground of lack of inventive step having regard to certain documents identified in the notice of opposition, the opposition being based in

particular upon one document, the closest prior art document. During the appeal proceedings the opponent raised the objection for the first time that the claimed invention lacked novelty in view of this closest prior art document.

7.1 It follows from what is stated above that an objection of lack of novelty is a different legal objection having a different legal basis from the objection of lack of inventive step. Therefore, the objection of lack of novelty cannot be introduced into the appeal proceedings without the agreement of the patentee, because it constitutes a "fresh ground for opposition" within the meaning of paragraph 18 of G 10/91.

7.2 Nevertheless, in a case such as that under consideration in the Decision of referral in case G 7/95, if the closest prior art document destroys the novelty of the claimed subject-matter, such subject-matter obviously cannot involve an inventive step. Therefore, a finding of lack of novelty in such circumstances inevitably results in such subject-matter being unallowable on the ground of lack of inventive step.

7.3 Having regard to the particular facts of the case before the referring Board in case G 7/95, it is not necessary for the Enlarged Board to answer the referred question insofar as it relates to a new allegation that the claims lack novelty in view of any other document than the previously cited closest prior art document.

Order

For these reasons it is decided that:

The question of law referred to the Enlarged Board of Appeal is to be answered as follows:


In a case where a patent has been opposed under Article 100(a) EPC on the ground that the claims lack an inventive step in view of documents cited in the notice of opposition, the ground of lack of novelty based upon Articles 52(1), 54 EPC is a fresh ground for opposition and accordingly may not be introduced into the appeal proceedings without the agreement of the patentee. However, the allegation that the claims lack novelty in view of the closest prior art document may be considered in the context of deciding upon the ground of lack of inventive step.

The Registrar:


J. Rückerl

The Chairman:


P. Gori


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